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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590

06/12/2008

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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

06/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/007,812	<b>Applicant(s)</b> SUPINSKI, ROBERT S.	
	<b>Examiner</b> DAVID COMSTOCK	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2008 and 26 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

The drawings filed 09 January 2008 are accepted.

### ***Specification***

The term “ring” as used throughout the entire specification, including the abstract, is inconsistent with the actual structure that is shown in the Figures, since the structure is a disc and not an annular ring. Moreover, the disc does not “surround” the first and second members but rather it is located between the two members. Appropriate correction is required. While Applicant can be his/her own lexicographer, this latitude cannot be extended to the point that the terms used are inconsistent with their common meaning. Applicant’s disclosure sets forth a disc between the first and second member. It is not identical to the structure shown in Cohen (6,146,423). Cohen refers to element 10 as a ring because it is a ring. (See col. 3, line 3, as cited by Applicant in the Remarks.)

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of 35 U.S.C. 102(b) and 35 USC 103(a), respectively, which form the basis for the rejections under this section made in this Office action:

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35 USC 102(b)

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

35 USC 103(a)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-8 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (5,522,901), or alternatively, under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (5,522,901).

Thomas et al. disclose the claimed invention including a patellar prosthesis comprising a first porous biocompatible metal member 10, 14 and a second biocompatible polyethylene member 2 (see, e.g., Abstract; Fig. 1; col. 3, lines 8, 9, 17-19 and 24-28; col. 4, lines 16-64). The first member has a rounded surface 12 for fixation in the patella and an opposite flat surface 17. The flat surface is defined by an integrally attached protruding annular ring 16 having a central aperture therein and an outer flange portion. The second member is a biocompatible joint articulating plastic material and has a central extending projection that fits into the central aperture of the first member. The opposite surface 5 of the second member is rounded. The two members can be joined by projections that extend into snaps (see, e.g. col. 3, lines 33-38). At least during assembly, a gap (including at the periphery of the device) exists between the members. In addition, since the material from which the first member is made comprises pores, it is necessarily a porous material. It is noted that Applicant's own specification repeatedly recites a "porous surface," and this has been construed as

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enabling the limitations in the claims, including the limitation “a first member fabricated from a porous metal.” However, even if the porosity of first member 10, 14 were disregarded, it would have been obvious to have substituted either a porous coating or a porous material, e.g., for improved ingrowth and attachment, as this merely involves the substitution of suitable materials known in the art. Regarding the type of metal or plastic used, it would have been further obvious to have formed the metal members from titanium or cobalt chrome and the plastic member from polyethylene, e.g. for cost or durability, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 2-4, 9-11 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (5,522,901) in view of Frazier (4,041,550, of record).

Thomas et al. disclose the claimed invention except for explicitly reciting the plurality of apertures about a periphery of the device. Frazier discloses a patellar implant and teaches providing a plurality of apertures about a periphery of the device in order to allow sutures to pass therethrough and retain a damaged patella in place (see, e.g., Figs. 2 and 4; col. 1, lines 5-8; and col. 2, lines 15-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the implant of Thomas et al. with a plurality of apertures about a periphery of the device, in view of Frazier, in order to allow sutures to pass therethrough and retain a damaged patella in place.

Claims 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. (5,522,901) in view of Johnson (5,609,640).

Thomas et al. disclose the claimed invention except for explicitly reciting the use of a bone growth material. Johnson discloses a patellar implant and teaches providing the pores thereof with hydroxyapatite in order to make the implant more secure and durable (see, e.g., Fig. 3a; col. 2, lines 54-57; and col. 3, lines 8-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the implant of Thomas et al. with a bone growth material such as hydroxyapatite, in view of Johnson, in order to make the implant more secure and durable and increase its reliability.

### ***Response to Arguments***

Applicant's arguments filed 26 December 2007 have been fully considered but are not fully persuasive.

In response to Applicant's argument that Metzger et al. (6,280,476) is not prior art in light of the 1.131 affidavit, Examiner has withdrawn this grounds of rejection.

However, the remaining grounds of rejection are maintained. It is noted that all of the devices of the applied references comprise at least a shape which is at least "conforming" (i.e., at least similar) to that of a natural patella of a typical patient. Moreover, as set forth in the rejection above, selecting a known material on the basis of its suitability for the intended use has been held to be within the general skill of a worker in the art as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733